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Attorney's Docket No. 035718/238971 (5718-142)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Pramod B. Mahajan	Confirmation No.:	8514
Appl No.:	09/954,950	Group Art Unit:	1638
Filed:	September 18, 2001	Examiner:	David H. Kruse
For:	RICE MLH1 ORTHOLOG AND USES THEREOF		

May 15, 2003

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated April 16, 2003, in which the Examiner has required restriction between Group I, namely claims 1-6, 10, 11, 13-16, 19, 20, 23, 27, and 28, Group II, namely claim 7, Group III, namely claims 8 and 9, Group IV, namely claims 12, 14-16, 22, and 23, Group V, namely claims 17, 18, and 23, Group VI, namely claims 21 and 23, Group VII, namely claims 24-26, and Group VIII, namely claim 29. Applicant hereby provisionally elects without traverse to prosecute the claims of Group I (Claims 1-6, 10, 11, 13-16, 19, 20, 23, 27, and 28) and expressly reserves the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims.

With respect to divisional applications directed to subject matter present in Groups II – VIII, Applicant takes this opportunity to traverse the separation of subject matter of Groups III and V. Group III claims are directed toward a genetically modified rice plant comprising a mutant MLH1 gene due to the presence of a transposon. Group V claims are directed to a method for increasing the efficiency of targeted gene mutation comprising transposon tagging an endogenous MLH1 gene in a plant. The Examiner has stated that inventions III and V are unrelated, because the method of Group V is not disclosed as being capable of producing the genetically modified rice plant of Group III. This restriction of claims 8 and 9 from claims 17, 18, and 23 is respectfully traversed.

Applicant submits that page 23, line 6, through page 24, line 12, of the specification describes the embodiment of the invention that comprises transposon tagging an endogenous plant gene MLH1. SEQ ID NO:1 is identified as being an example of an MLH1 gene. Therefore, the method of Group V (transposon tagging an endogenous MLH1 gene in a plant, transforming the plant with a nucleotide sequence having at least one mutation or one sequence to be homologously recombined, and selecting a transformed plant) is disclosed as being capable of producing a genetically modified rice plant having an endogenous MLH1 gene with a mutation due to the presence of a transposon.

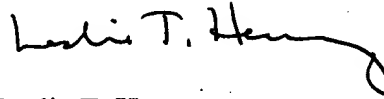
Applicant further points out that if a search and examination of an application can be made without serious burden, the Examiner must examine the application on the merits even though it may include claims that are independent and distinct inventions. MPEP §803. In the present case there would be no serious burden of search if the restriction requirement of Groups III and V was not set forth. Applicant submits that a search directed to a genetically modified plant comprising an endogenous MLH1 gene having a mutation due to the presence of a transposon and methods for making such a plant in accordance with claims 17, 18, and 23 would result in the identification of references directed to the genetically modified rice plant of claim 8, and transformed seeds thereof as set forth in claim 9. Further, if the quantity of references obtained presented an undue burden, Applicant points out that restriction can in fact be made at any time during prosecution. Thus, the Examiner has the opportunity to avoid undue burden that could result from rejoinder of the claims.

Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned so that further examination of this application can be expedited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



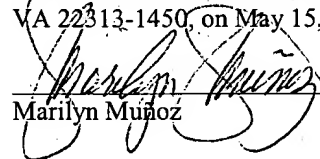
Leslie T. Henry
Registration No. 45,714

CUSTOMER NO. 29122
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Raleigh Office (919) 862-2200
Fax Raleigh Office (919) 862-2260

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Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 15, 2003



Marilyn Muñoz